

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Rabbani et al.
Application No. 09/896,897
Filed: June 30, 2001
Atty Docket No. ENZ-60

OFFICE OF PETITIONS
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**REQUEST TO VACATE ORDER TO SHOW CAUSE WHY DECISION
REVIVING THIS APPLICATION SHOULD NOT BE VACATED**

Sir:

This is a Request to Vacate the Order to Show Cause Why Decisions Reviving Applications Should Not Be Vacated ("Order") issued in the above-captioned application. A Request to Expedite the treatment of this Petition and a Petition to Expunge are being submitted separately.

Petitioner respectfully urges that no fees are due because the Show Cause Order was improperly issued. Nevertheless, should the USPTO determine that any fees are required to have the Order vacated, including any extension of time fees, the USPTO is authorized to charge Deposit Account No. 50-0206.

Background

The instant application first became abandoned on December 13, 2001, for failure to reply to the Notice of Missing Parts of October 12, 2001.

Ron Fedus, patent counsel for the assignee, Enzo Biochem, Inc. ("Enzo"), filed a petition to revive under 37 C.F.R. § 1.137(b) on June 28, 2002.

In his petition, Mr. Fedus stated that "the delay in taking action was unintentional as was the entire delay in filing the required reply from the due date for the reply until the filing of this grantable petition was unintentional." Mr. Fedus also filed a proposed reply and paid the required fee. The USPTO granted Mr. Fedus' petition to revive almost eight months later on February 19, 2003. The Decision was signed by Latrice Bond of the Office of Petitions.

This application again became abandoned on September 3, 2005, for failure to properly reply to the final Office action mailed March 2, 2005. A reply under 37 CFR 1.116 and a petition for a three month extension of time (with the required fee) were filed September 2, 2005. However, since the reply did not place the application in condition for allowance as noted in the Advisory Action of October 12, 2005, and a Notice of Appeal was not filed on or before September 2, 2005, the application became abandoned. A Notice of Abandonment was mailed November 15, 2005.

Mr. Ron Fedus filed a petition to revive under 37 C.F.R. § 1.137(b) on November 29, 2005—14 days after the mailing of the Notice of Abandonment.

Mr. Fedus' filing included a PTO/SB/64 form (Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. 1.137(b)), a communication, a Notice of Appeal and the requisite fees. In the communication, Mr. Fedus stated that he "inadvertently failed to file a Notice of Appeal" with the September 2, 2005 reply. The

USPTO granted the petition about 10 weeks later on February 13, 2006. The petition decision was signed by Petitions Examiner Retta Williams.

At each time noted above, Rule 1.137(b) required a Petitioner to: (i) state that “the entire delay from the due date for the required reply to the date of filing a grantable petition was unintentional”; (ii) file a proposed response; and (iii) pay a fee. 37 C.F.R. § 1.137(b) (1997); *see also* Manual of Patent Examining Procedure (MPEP) § 711.03(c) (8th ed., Aug. 2001; 8th ed. rev. 1, Aug. 2003) (“[T]he Office will generally require only the statement that the entire delay in providing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional...”).

On July 1, 2008, well over five and two years after granting the first and second petitions to revive, respectively, the USPTO issued the instant Order. The Order requires Enzo to show cause why the USPTO should not vacate its two earlier decisions reviving the application.

In its Order, the USPTO indicates that during all periods relevant to the decisions on petition in this application Enzo was required to “show that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.” Order, page 6. The USPTO also contends that Mr. Fedus' testimony in an unrelated deposition proceeding supported an inference that the delay was actually intentional. *Id.* at page 12.

A. The USPTO Is Applying the Wrong Standard For Petitions to Revive Filed In 2002 and 2005 In the Instant Application

1. 37 C.F.R. § 1.137(b) Only Required A Statement, Not a Showing, That “The Entire Delay ... Was Unintentional”

The USPTO erroneously asserts that Enzo was required “to show that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition” was unintentional. Order, page 6.¹ Rather, during all periods relevant to the petitions in this application, Enzo was only required under the terms of 37 C.F.R. § 1.137(b), to include a statement that “the entire delay ... was unintentional.” The USPTO accepted Mr. Fedus’ statements of unintentional delay and, in each instance, revived the application.

At the times Mr. Fedus filed the petitions, 37 C.F.R. § 1.137(b) authorized the USPTO to seek additional information if there was a question whether the delay was unintentional. The USPTO declined to do so on two separate occasions. Indeed, Mr. Fedus’ statements were accepted twice, by two different officials from the Office of Petitions. The USPTO has not provided any basis, nor is there any basis apparent in the instant file or the regulations themselves, for belatedly second-guessing its decisions and requiring that Enzo show cause why these decisions should not be vacated.

2. The USPTO Has Not Provided Any Evidence That the Delay Was Intentional

As noted above, the MPEP in effect in June 2002 and November 2005 made clear that a petition to revive under 37 C.F.R. § 1.137(b) will generally be granted.

The USPTO has provided no evidence that the delay herein was intentional. Instead, it merely alleges that Mr. Fedus’ testimony in an unrelated proceeding, and a purported

¹The requirement of a “showing” is imposed for petitions under 37 CFR 1.137(a) *only*. See MPEP 711.03(c), subsection III, paragraph (F) (7th ed. July 1998; 8th ed., Aug. 2001).

"pattern" of abandonment and delay, supports an inference that Enzo's delay in this case was intentional. Enzo respectfully submits that neither of these pieces of information supports the Order.

First, nothing in Mr. Fedus' testimony suggests that he intentionally abandoned the instant application, intentionally delayed filing the Petition to Revive, or intentionally delayed the prosecution of the inventions(s) described in this application.² Mr. Fedus testified that as far as he could recall, the delay in filing a petition to revive in a different, unrelated application was due in part to "dealing with the previous office action, trying to figure out the response to reply," and "preparing a response to the last office action." Order, page 12. But this testimony is irrelevant to this application or whether its abandonment, or its delay, was intentional. Moreover, even if this testimony was relevant, Mr. Fedus' explanation is reasonable. Once a party realizes that an application has been unintentionally abandoned, it always takes some amount of time to investigate the circumstances that led to abandonment and prepare and finalize a response. The USPTO has failed to show that Mr. Fedus' actions in this case, or his testimony in an unrelated proceeding, is in any way unreasonable. Rather, the evidence of record demonstrates that Mr. Fedus' actions were reasonable and the delay was unintentional.

² See *Goss International v. MAN Roland, Inc.*, No. 03-CV-513-SM, 2006 U.S. Dist. LEXIS 53245 at * 5 (court distinguishing between abandonment of an application that may be revived under 37 C.F.R. § 1.137(b) *e.g.*, as evidenced by the filing of a continuation application to further prosecute the disclosed invention, and the irremediable abandonment of the invention itself.) In this case, Enzo continued to prosecute the inventions disclosed in the instant application through subsequent continuing applications.

Second, the purported "pattern" referenced in the Order relates to abandonments and revivals in *other applications*. But this information has nothing whatsoever to do with this application or whether its delay was intentional.

Accordingly, since Enzo complied with 37 C.F.R. § 1.137(b) in effect at the time the petitions to revive were filed, and since the USPTO has not provided any evidence that the delay in this application was intentional, Enzo respectfully requests that the Order be vacated.

B. The Order—Issued Well Over Two Years After The USPTO’s Grant of Enzo’s Last Petition—is Unreasonable

Under 37 C.F.R. § 1.137(b), the USPTO "may require additional information where there is a question whether the delay was unintentional." 37 C.F.R. § 1.137(b)(3) (Dec. 1, 1997). The USPTO twice—by way of two deciding officials—considered the matter of delay in this application and *each time* accepted counsel’s statements without requiring additional information. Equity, fairness, and procedural due process estop the USPTO from demanding such information *well over five years and well over two years* after granting the petitions to revive the application.³

Courts have held that an agency may reconsider its decisions so long as it does so "within a reasonable time after the first decision." *See Belville Mining Company v. United States of America*, 999 F.2d 989, 997 (6th Cir. 1993) (citing *Dun & Bradstreet Corp. Found. v. United States Postal Serv.*, 946 F.2d 189, 193 (2d Cir. 1991); *Mazaleski v. Treusdell*, 562 F.2d 701, 720 (D.C. Cir. 1977); *Bookman v. United States*, 453 F.2d 1263, 1265 (Ct. Cl. 1972)). The U.S. Court of Claims has explained that, "absent contrary legislative intent or other affirmative

³ *See In re Zacharin*, 1 USPQ2d 1413, 1417 (Comm’r Pat. 1986) ("[i]t is not in the public interest to permit government employees or Government agencies to belatedly "re-open" appeals to reargue the sufficiency of the evidence or supplement the record.")

evidence, this court will sustain the reconsidered decision of an agency, as long as the administrative action is conducted within a *short and reasonable time period*." *Belville Mining Company*, 999 F.2d at 1000 (citing *Bookman v. United States*, 453 F.2d at 1265) (emphasis added). The Court of Claims later clarified that "[w]hat is a short and reasonable time period will vary with each case, but absent unusual circumstances, *the time period would be measured in weeks, not years*." *Id.* at 1000 (citing *Gratehouse v. United States*, 512 F.2d 1104, 1109 (Ct. Cl. 1975)) (emphasis added). The court added that since this reasonable time period has run, 'there is no longer an opportunity to correct the procedural error retroactively.' *Id.* at 997 (citing *Gratehouse*, 512 F.2d at 1109).

What constitutes a "short and reasonable time" within which an agency may reconsider its decisions will depend on the facts of each case. *See Gratehouse*, 512 F.2d at 1104, 1109. Nevertheless, numerous courts have found that periods of more than one year are not "short and reasonable time[s]." *See id.* at 1110 (holding that a "hearing 2 years after a hearing could have been held was far too late to qualify as reconsideration."); *C.J. Langenfelder & Son, Inc. v. United States*, 341 F.2d 600, 604 (Ct. Cl. 1965) (holding that reconsideration made more than a year after original decision was "much more than a 'reasonable period.'"); *Gabbs Exploration Co. v. Udall*, 315 F.2d 37 (D.C. Cir. 1963) (holding passage of 27 years made agency reconsideration untimely); *Umpleby v. Udall*, 285 F.Supp. 25, 30 (D. Colo. 1968) (holding reconsideration after 16 years to be untimely).

In this case, the USPTO is reconsidering the grants of petitions to revive rendered *well over five and well over two years* after granting the petitions to revive. This is far more than a "short and reasonable" time. As a result, Enzo is placed at an unfair disadvantage. Indeed, there are numerous problems associated with long lapses in time, including, for example,

faded memories. That is certainly true in this case. *See, e.g.,* Order at page 12 ("attorney Fedus explains the delay *to the extent that he can recall...*") (emphasis added). Furthermore, the USPTO has already twice determined that there is no basis in the record to question the assertions of unintentional delay. The USPTO has thus exceeded its authority in seeking to reconsider its decisions rendered over two years after granting the last petition to revive this application. Accordingly, Enzo respectfully requests that the Order be vacated.

C. Relief Requested

As discussed above, it is respectfully requested that the USPTO provide the following relief:

- 1) Vacate the Order issued in the above-captioned application as an untimely attempt to reconsider a previous decision of the USPTO and as being based on insufficient evidence that the earlier grant of the petition under 37 C.F.R. § 1.137(b) was improper;
- 2) Expunge from the public record any mention of confidential applications currently referenced in the Order to Show Cause for the instant application as requested in a concurrently filed petition to Expunge under 37 C.F.R. § 1.181; and
- 3) Reset the time period for responding to the Order to Show Cause to run from the date of decision on the concurrently filed Request to Expunge.

D. Conclusion

In view of the above remarks, early notification of a favorable consideration is respectfully requested.

Respectfully submitted,

HUNTON & WILLIAMS LLP

Dated: December 31, 2008

By:

A handwritten signature in black ink, appearing to read "R. M. Schulman", written over a horizontal line.

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